



9
UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

9
(mar 11/3/00)

William C. Cray
Levin & Hawes LLP
384 Forest Avenue, Suite 13
Laguna Beach, CA 92651

(For Patent Owner)

Paul E. Crawford
Connolly Bove Lodge & Hutz LLP
1200 Market Street
Wilmington, DE 19801

(For Requester #1)

Ross F. Hunt, Jr.
Larson & Taylor
1199 North Fairfax St., Suite 900
Alexandria, VA 22314

(For Requester #2)

In re reissue application of
Dickens
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

MAILED
NOV 06 2000
REEXAM UNIT

In re Dickens
Reexamination Proceeding
Control No. 90/005,592
Filed: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,628
Filed: February 2, 2000
For: U.S. Patent No. 5,806,063

DECISION, SUA SPONTE,
TO MERGE REEXAMINATION
AND REISSUE PROCEEDINGS

In re Dickens
Reexamination Proceeding
Control No. 90/005,727
Filed: May 16, 2000
For: U.S. Patent No. 5,806,063

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,806,063 issued to Bruce M. Dickens on September 8, 1998, and a certificate of correction issued in the '063 patent on November 30, 1998.
2. The Commissioner of the USPTO ordered, on his own initiative, reexamination of the '063 patent on December 21, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,592.
3. On February 2, 2000, a third party requester (requester #1), Paul E. Crawford, filed a request for reexamination, and the request was assigned Control No. 90/005,628.
4. On February 18, 2000, patent owner filed in the '5592 proceeding, a statement under 37 CFR § 1.530 in response to the Commissioner's order for reexamination.
5. On February 23, 2000, patent owner filed a reissue application which was assigned Application No. 09/512,592.
6. Reexamination was ordered in the '5628 proceeding on March 10, 2000.
7. On May 16, 2000, a third party requester (requester #2), Ross F. Hunt, Jr., filed a request for reexamination, and the request was assigned Control No. 90/005,727.

8. Reexamination was ordered in the '5727 proceeding on August 10, 2000.
9. On October 10, 2000, patent owner filed in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000.
10. A requester's reply under 37 CFR § 1.535 has not been received from requester #2 as of the date of this decision, and the time for filing same has not yet expired.

DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the three reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.520 in the '5592 reexamination proceeding, and pursuant to § 1.525 in the '5628 and '5727 reexamination proceedings, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making

a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution histories of the '5592, '5628 and '5727 reexamination files shows that (a) the '5592 and '5628 reexaminations are awaiting a first Office action by the examiner and (b) the '5727 reexamination is awaiting the filing of a requester's reply under 37 CFR § 1.530 or the expiration of the time to do so (after December 11, 2000). The original specification, drawings and patent claims are presently in each of the '5592 and '5628 and '5727 reexamination files.

A review of the reissue (Application No. 09/512,592) prosecution history shows that the reissue application was published in the *Official Gazette* on May 16, 2000. Two months from the publication of the present reissue have passed, and the application is awaiting a first Office action on the merits by the examiner. Further, in addition to the original unamended patent claims in the reissue application, applicant has submitted new claims 16-76 for consideration. Thus, the claims are not identical in all four proceedings. In order to provide efficient and prompt handling of all four proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the three reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the first, second, and third reexamination proceedings will be conducted in accordance with the decision set forth below.

09512592 09005592 09005628 09005727

DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The patent owner is required to maintain identical amendments in the reissue application and three reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all four files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within TWO (2) MONTHS¹ of this decision placing the same amendments in all four cases**, specifically, Application No. 09/512,592, and Control Numbers 90/005,592 and 90/005,628 and 90/005,727. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Requirement for Information in the Merged Reissue and Reexamination Proceedings

Patent owner is required under 37 CFR § 1.105 to provide the information identified below that the Office has determined is reasonably necessary to the examination of the merged proceeding.

The information is required to determine which art, outside of the existing U.S. patents, is relevant to the claimed subject matter of converting date information identifying dates from more than a single century, from formats containing 2 digits for year data to formats containing more than 2 digits for year data in computer memory. The requirement for additional art is necessary because limited amounts of art related to the claimed subject matter are available within the Office, and the Office needs to consider all of the prior art that is relevant to the patent under reexamination and reissue that the patent owner/applicant has become aware of.

¹ Generally, a one (1) month period is set for the filing of the housekeeping amendment in response to a merger decision. In the present instance, however, a two (2) month period is set for response to the requirement for information under 37 CFR 1.105 made in the next part of this decision, in order to provide sufficient time to comply. Thus, a two (2) month period has also been set for the filing of the housekeeping amendment, in order to avoid the potential confusion of two different periods running against the applicant/patent owner.

The information to be provided is as follows:

Patent owner/applicant is requested to provide citations and copies of any prior art, published prior to the filing date of the applicant's patent application, which the patent owner is aware of, which is relevant to the claimed aspects of the invention of-

- 1) converting date information in computer memory from a format whose data structure representing the year contains 2 digits to a format whose data structure representing the year contains more than 2 digits;
- 2) selecting ranges of years which will be assigned to different centuries in date conversion;
- 3) establishing the criteria for selecting such ranges of years;
- 4) creating the sequence for century, year, month and date data within the data structure for date data; and
- 5) identifying and converting multiple different date formats into a common date format, including particularly conversion that removes embedded slash marks from eight character date formats,

which prior art has not yet been submitted in a prior art statement, prior art citation or information disclosure statement in any of the reissue or three reexamination proceedings pertaining to this patent to date.

The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the patent owner/applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

Patent owner/applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56.

A complete response to the present Decision Merging Reissue and Reexamination Proceedings **must include** a complete response to this requirement under 37 CFR § 1.105. Where the patent owner/applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to this requirement, for that item.

The time period for reply to this requirement coincides with the time period for providing a housekeeping amendment in the Merged Reissue and Reexamination Proceedings, i.e., **within TWO (2) MONTHS of this decision.**

Failure to timely respond to the present 37 CFR 1.105 requirement will result in abandonment of the reissue application and the dissolving of the merged proceeding as to the reissue application; the reexamination proceedings would remain merged, and prosecution of such merged reexamination proceeding would continue until termination of the proceeding, i.e., issuance of a reexamination certificate.

IV. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at 2 months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the three reexamination proceedings. Each action will contain identifying data for all of the cases, i.e., the reissue application and the three reexamination proceedings. Each action will be physically entered into all four files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with four copies being filed for entry in the four files, with each of the four bearing a signature. Any such responses must be served on the requesters, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved *as to the reissue application*. With respect to the three reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the three reexamination proceedings that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding *as to the reissue application*. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the three reexamination proceedings that will remain merged as one proceeding.

V. Requester's Reply under 37 CFR § 1.535 for the '5727
Proceeding

On October 10, 2000, patent owner filed, in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000. Pursuant to 37 CFR § 1.530, any requester reply to patent owner's statement must be filed by December 11, 2000. No reply has been received from requester #2 as of the date of this decision, and the time for filing same has not yet expired. Accordingly, the examiner will delay action on the merits until the earlier of (a) the receipt of the reply, or (b) December 12, 2000, plus time for matching a reply that might have been timely filed.

CONCLUSION

1. The above-identified reissue application and first, second and third reexamination proceedings ARE MERGED into a single consolidated proceeding.
2. The reissue application file and the three reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within TWO (2) MONTHS of this decision**, placing the same amendments in all cases of the present merged proceeding.
4. Pursuant to Part III of this decision, Patent owner is required under 37 CFR § 1.105 to provide prior art information to the Office which is reasonably necessary to the examination of the present merged proceeding. A complete response to the enclosed Decision Merging Reissue and Reexamination Proceedings **must include** a complete response to this requirement. The time period for reply to this requirement coincides with the time period for providing a housekeeping amendment in the Merged Reissue and Reexamination Proceedings, i.e., **within TWO (2) MONTHS of this decision**.

5. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceedings **after** both of the following events have occurred:

I. The earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases **and** a response to the requirement under 37 CFR § 1.105 to provide information, or (b) the expiration of the TWO (2) month period from the mailing of this decision for filing the amendment.

II. The earlier of (a) the filing of a requester's reply under 37 CFR § 1.535 by the requester of the '5727 proceeding (requester #2), or (b) the expiration of the time to do so after December 11, 2000 plus time for mailing the reply.

6. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/512,592	02/23/00	Bruce Dickens	
PATENT NUMBER	DATE OF THIS NOTICE		PAPER NUMBER
5,806,063	11/06/00		10

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Requester | Paul E. Crawford
(name, address) | Connolly Bove Lodge & Hutz LLP
| 1200 Market Street
| Wilmington, DE 19801

Ross F. Hunt, Jr.
Larson & Taylor
1199 North Fairfax St., Suite 900
Alexandria, VA 22314

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/005,592, filed 12/21/99, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

No. 90/005,628, filed 02/02/00; and No. 90/005,727, filed 05/16/00